pending in the present application. Reconsideration of the present patent application is respectfully requested in view of the appended remarks.

INFORMALITIES IN THE SPECIFICATION AND DRAWINGS

Applicants have made changes to properly reflect that Application Serial No. 07/936,384 was abandoned, and a continuation was filed as Application Serial No. 469,491, which issued as U.S. Patent No. 5,764,747. Applicants have also made changes to the specification to correct typographical and grammatical errors.

Applicants have amended FIG. 6 of the drawings with the addition of the label "602," as shown in red in the attached copy. This amendment to FIG. 6 is a typographical error, and the correction has support in the specification on page 17, line28.

CLAIM REJECTIONS

Rejection of Claims 1-11 and 13-16 Under 35 U.S.C. 102(b)

Claims 1-11 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by *Morganstein* (U.S. Patent No. 5,029,196). Specifically, the Examiner stated that, with regards to Claim 1, *Morganstein* teaches a method for routing a call based on the identity of an originating source of the call, comprising the steps of maintaining a plurality of routing lists (FIG. 1, 54), each routing lists being associated with at least one originating source (FIG. 3, 82) and comprising a plurality of directory numbers (FIG. 3, 82, 84,88, and 90); receiving the call from the originating source (any number 82 of Fig. 3); selecting a routing list associated with the

originating source from the plurality of routing lists (col. 5, lines 24-33 and lines 45-50); and

directing the call according to the routing list (col. 5, lines 50-51).

Morganstein Fails to Disclose All Claim Limitations of Claims 1-11, and 13

Applicants submit that the *Morganstein* patent fails to teach the specific combination of

elements recited by independent Claim 1 as amended. *Morganstein* does not sequentially route

calls to a list of directory numbers on a routing list. Instead, the method of *Morganstein* only

routes the incoming call to a single designated number for each incoming call event.

Morganstein discloses a method whereby a called party can designate one or more of the

listed numbers from a "list of telephone numbers associated with potential calling parties" as

important, and associate each telephone number in the list with "an indication of the intended

disposition of the call." Col. 2, lines 15 – 25. Thus, *Morganstein's* invention relates to taking a

number that is stored in a system (FIG. 3, col. 1 of the table) and associating that number with

one destination number of the called party (Fig. 3, col. 2 of the table). That *one* destination

number of the called party can be pre-programmed by the called party (See Fig. 4a, 136, and Fig.

4b). For example, the called party can specify that a calling party possessing the number "214-

220-8287," as shown in 54 of FIG. 3, should be routed to "Ext. 222," as shown in FIG. 3. Thus,

any "list" of *Morganstein* is a list of individual calling numbers, to be associated in a one-to-one

correspondence with *one* specific number of the called party out of a list of possible numbers.

A particular caller may be "directly connected" to the called party (col. 1, lines 23-24),

connected to "voice store and forward facilities" (col. 1, lines 34-35), <u>or</u> routed to "an alternate

destination, such as a secretary or a switchboard attendant" (col. 1, lines 40-42). For each call

event, the caller is directed to only one destination number. *Morganstein* does not disclose the step of directing a call "sequentially to the directory numbers on the routing list", which is recited by amended Claim 1. The specification supports the language recited by Claim 1: A subscriber "provides routing lists;" page 7, lines 17-18. Each of the plurality of routing lists "contains various directory numbers that identify phone lines where the subscriber may be accessed." Page 2, lines 22-23. "Calls placed to the called party's number will be routed by the personal number system to the various directory numbers until either the subscriber is located or the list of destination numbers has been exhausted." Page 2, lines 23-26. Because *Morganstein* does not disclose the "plurality of routing lists" or the "routing lists" that are claimed in Claim 1, Applicants respectfully request the Examiner to withdraw the rejection of Claim 1.

Based on the remarks in the preceding paragraphs, Applicants respectfully submit that the Examiner's rejection of Claims 2 - 13 should also be withdrawn.

Morganstein Fails to Disclose All Claim Limitations of Dependent Claims 3 and 7

The Examiner rejected Claims 3 and 7, stating that *Morganstein* teaches the method wherein the selecting a routing list step further comprises the steps of. requesting the originating source to provide an identification code (col. 1, lines 41-45); receiving the identification code (col. 1, line 46); retrieving an associated touting list for the identification code (col. 2, lines 20-45); and retrieving a default routing list of the associated routing list does not exist (col. 2, lines 46-58). This rejection is respectfully traversed.

Morganstein, col 1, lines 41-45, teaches features in a telecommunications system that processes incoming calls by first answering the call with a pre-recorded message that invites the

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calling party to dial the *extension number* of the desired party. At col. 1, lines 46-55, *Morganstein* further discloses that after receiving the telephone number input by the calling party, the system prompts the calling party to verbally input *his or her name*. The call is then completed to the called party by announcing the recorded name or identity of the calling party to the called party.

Morganstein, does not, however, disclose the step of requesting the originating source of the call to provide a *code*. The caller's name is not used as a code in the *Morganstein* reference. The caller's name is only used as part of the announcement. Not having a code would allow *anyone* to dial the extension number of the called party and verbally input his or her name (or a telephone number that the caller knows that the called party has given priority to), whether that person is who they claim to be or not. This can lead to an unwanted party reaching the called party at an inopportune time. On the other hand, having a code that can be entered has several advantages. First, and most important, is that a code *is not line dependant*, and it is *not* geographically dependent. *Morganstein* teaches the ability to associate a calling party with a called number based on the calling line number, or its geographical location (col. 7, lines 46-53). Should the calling party in *Morganstein's* invention be calling from a remote location, such as a pay phone, the line would not be recognized, and the call would not be given the priority that was intended by the called party, or the priority given would be associated with a geography instead of a particular calling party. On the other hand, if the called party is allowed to enter a specific *code*, that party can be connected based on the priority intended by the called party. Further, a code will prevent a person who was not given a priority destination list from being able to reach the called party just by entering an extension that may be known to be given

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priority. This is a drawback that *Morganstein* does not account for or disclose. *Morganstein* does not show, disclose, or suggest the use of a code as a means of identifying the calling party, which is what is recited by Claims 3 and 7. Thus, Applicants respectfully submit that the Examiner's rejection of Claims 3 and 7 should be withdrawn.

Morganstein Fails to Disclose All Claim Limitations of Claims 8-10

The Examiner stated, regarding Claims 8- 10, that *Morganstein* further teaches the method wherein the selecting a routing list step further comprises the step of selecting the routing list from a group of routing lists identified for the originating party based on the day of the week or/and the time of the day the communication is received (col. 13, lines 15-18). This rejection is respectfully traversed.

The Examiner's citation, *Morganstein* col. 13, lines 15-18, reads "Indeed, the telephone user or programmer of the call processor can preselect destinations for various calling parties to optimize the user's time and efficiency." *Morganstein* does not, however, teach the ability to direct calls to the called party based on the time of the call, particularly, the time of the week, time of the day, or both. Claims 8 – 10 are directed to such. Thus, Applicants respectfully submit that the Examiner's rejection of Claims 8 – 10 should be withdrawn.

Rejection of Claim 12 Under 35 U.S.C. 103(a)

The Examiner Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Morganstein* as applied to Claim 1 above, and further in view of *Eisdorfer et al.* (U.S. Patent No. 5,706,339). This rejection is respectfully traversed.

The Examiner Has Failed to Establish a *Prima Facie* Case of Obviousness.

According to MPEP Section 2142, a prima facie case of obviousness must set forth the following elements:

1. The examiner must show "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

2. The Examiner must show that there must be a "reasonable expectation of success."

3. The Examiner must show that the cited references "teach or suggest all of the claim limitations."

Where the Examiner does not produce a prima facie case of obviousness, the Applicant is under no obligation to submit evidence of nonobviousness. In the case at hand, Applicants respectfully submit that the Examiner has failed to show some suggestion or motivation to modify the cited references or to combine the teachings of the references to achieve the invention defined by Claim 12.

Nothing in the references themselves suggest that the two arts may be combined. Part of the invention of the present application involves discovery of the problem, even if the solution may have been obvious once the source of the problem is identified.

To begin with, *Morganstein* is directed to allowing a subscriber (the called party) of a telephone service to direct calls to any one of a list of numbers where the subscriber can be reached. These calls are directed to selected numbers based on the identification of the calling line, or the geography of the originating call. (col. 2, lines 15-19; col. 2, lines 50-55). However, *Morganstein* does not recognize the problem that results if the call is directed to the subscriber at

a certain number designated by the subscriber, but the subscriber is not answering. Neither does *Morganstein* suggest a solution to this problem.

Eisdorfer, on the other hand, focuses on routing numbers to a number of locations. The concern of *Eisdorfer* is that a subscriber should not have to be at one particular number in order to receive all calls (col. 1, lines 11-30). *Eisdorfer's* further concern is that a party that desires to reach a subscriber (or called party) is able to be routed through a sequence of numbers that the subscriber can be reached at (col. 1, lines 30-45). Yet another concern of *Eisdorfer* is that if a subscriber calls another number that belongs to him (for example, calling his house from his cellular phone), that the subscriber's originating call does not get routed to the current number he is dialing from (the cellular phone) (col. 1, line 45– col.2 line 4). Finally, *Eisdorfer* was concerned that a caller might reach a number on the routing list that would be disconnected. *Eisdorfer*, however, does not disclose or identify any problem in which a subscriber should prioritize calls from non-subscribers that he or she received based on 1) the identification of the calling line, or 2) a code that is to be entered by the caller, or 3) a geographic location the call is originating from, or 4) on the time of day or the day of the week.

Because neither reference identifies the problems that the present application is directed to solving, there was no suggestion or motivation to modify the cited references or to combine the teachings of the references to achieve the invention defined by Claim 12. Consequently, Applicants respectfully submit that Examiner's rejection of Claim 12 should be withdrawn.

NEW CLAIMS

New Claims 17 and 18 are dependant claims that allow a call to be identified and routed based on the identification of a speech sample from a calling party. In the backgrounds of both the present application (page 4, lines 11-29) and *Morganstein* (col. 1, lines 47-55), there is described features of a telecommunications system that process incoming calls by first answering the call with a recorded message that prompts the calling party to verbally input his or her name, which is recorded. The call is then completed to the called party and the recorded name of the calling party is presented to the called party. The called party then decides whether to accept or reject the incoming call (Application page 4, lines 11-29) and *Morganstein* (col. 1, lines 47-55).

New dependant Claims 17 and 18 recite methods whereby the calling party's call is routed based on a speech sample that is provided by the calling party. New Claims 17 and 18 are supported in the specification of the present application on page 15, line 18 ("providing a speech sample"). Different from having the calling party provide a name, and then presenting the name to the called party, the processing by speech sample allows a calling party's identity to be determined based on the speech sample and routed accordingly to a destination list so that the called party does not need to respond at all. For this reason, Applicants respectfully submit that new Claim 17 and 18 should be allowed.

New Claims 19 – 24 incorporate the subject matter of Claims 3 and 7 – 10. Applicants respectfully ask that the Examiner refer to the arguments, which appear earlier in this response, that distinguish what is recited by these claims from the prior art.

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CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed August 17, 1999. Applicants thank the Examiner for the Examiner's consideration of these remarks. Applicants submit that the pending claims are patentable over the art of record and respectfully request allowance of these claims. If the Examiner believes that there are any issues that can be resolved by a telephone conference, an Examiner's amendment, or an in-person interview, please call Brenda Ozaki Holmes at (404) 949-2487.

Respectfully submitted,
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